

**REMARKS/ARGUMENTS**

In response to the Office Action dated April 11, 2007, claims 1, 14, 27 and 39-42 have been amended. Claims 1-42 are now active in this application. No new matter has been added.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

I. Claims 1-42 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner contends that the language “a receiving device which receives image selection information indicating that the stored image is selected to be retained stored” makes no sense and is grammatically incorrect.

The rejections are respectfully traversed. It is noted that 33-42 do not include such language.

Applicants strongly disagree with the Examiner that the above-noted language makes no sense and is grammatically incorrect. What is being recited is that the information that the receiving device receives is selection information indicating that the image captured by the image capturing device, which is stored by the image storing device, is selected to be retained stored (in the image storing device). The word “retain” is defined the American Heritage College Dictionary, copyright 2000, 1997, 1993 and includes the definitions “(1) to maintain possession of, (2) to keep or hold in a particular place, condition or position”. Retained is merely the past tense of the word retain. Another word that could have been used is “maintained”. However, Applicants can be their own lexicographer.

In view of the above, the sentence is grammatically correct and a person of ordinary skill in the art would understand the metes and bounds of the invention.

At any rate, independent claims 1, 14 and 27 have been amended to expedite prosecution. Claim 1 now recites, “a receiving device which receives image selection information indicating that the image stored in the image storing device is selected to remain stored and not removed from the image storing device”, claim 14 now recites, “a receiving device which receives image selection information sent from the terminal unit indicating that the image stored in the image storing device is selected to remain stored and not removed from the image storing device” and claim 27 now recites, “a sending device which sends the image selected by the image selecting device and image selection information indicating that the stored image is selected to remain stored and not removed”. Consequently, withdrawal of the rejection of claims 1-32 (claims 33-42 do not include this language) is respectfully solicited.

**II.** Claims 1-42 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner contends that he cannot determine what the “determining device” is.

The rejections are respectfully traversed and the rejection of claims 1-32 on this basis is objected to since claims 1-32 do not include a “determining device”.

Case law precedent has established that an analysis under 35 U.S.C. § 112 begins with a determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language is viewed not in a vacuum, but in light of the teachings of the prior art and of the application disclosure as it would be interpreted by one possessing the ordinary level of skill in the art. *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977); *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

A decision on whether a claim is invalid under this section of the statute requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification, *Seattle Box Co. v Industrial Crating & Packing*, 731 F.2d 381, 385, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984).

The Examiner's problem concerning not being able to determine what the "determining device" is results from the fact that the Examiner is reading the claims in a vacuum and not in light of the specification, as is required.

The "determining device", recited in claim 33, "determines whether or not to move the image recorded on the recording device to a record medium by comparing at least one of the capacity, quantity, recording period and a current date thereof recorded on the recording device to corresponding at least one of predetermined thresholds". A person of ordinary skill in the art, armed with the present specification, would understand that the "determining device" can be, for example, image storing sever 40 (see Figs. 1 and 10 of the present application) or server 190 (see Figs. 14 and 15 of the present application). Attention is directed to the descriptions at page 11, line 1 to page 12, line 32 and page 15, line 23 to page 23, line 5 of the present application.

The criticism of the claims is urged to be directed to breadth of scope and not indefiniteness. As such, the rejection improperly attempts to limit the scope of the claims by requiring additional limitations under the guise that such limitations are necessary to make the claims definite.

It is submitted that when "determining device" is read in light of the specification, an artisan would readily understand the metes and bounds of the claimed invention.

It should be noted also that the disclosure need not recite the claim language in *haec verba*. *In re Smith*, 481 F.2d 910, 178 USPQ 620 (CCPA 1973).

Consequently, withdrawal of the rejection of claims 33-42 (claims 1-32 do not include a “determining device”) as being indefinite for reciting “determining device” is respectfully solicited.

**III.** Claims 39 and 40 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner contends that he does not understand what is meant by “the recording device does not duplicately record the same image as that already recorded on the recording device”, recited in claim 39, and “the moving device does not duplicately move the same image as that already moved to the record medium”, recited in claim 40.

The rejections are respectfully traversed.

Attention is directed to the description, for example, at page 22, lines 8-16 of the present application, which describes the subject matter of claims 39 and 40. It is submitted that a person of ordinary skill in the art, armed with the present specification, and this referenced portion of the present application in particular, would understand the meets and bonds of the claimed invention.

At any rate, claims 39 and 40 have been amended to expedite prosecution. Claim 39 now recites:

...wherein  
the recording device does not record an image that is a duplicate of an image that is already recorded on the recording device.

Claim 40 now recites:

... wherein  
the moving device does not move an image that is a duplicate of an image that has already been moved to the record medium.

Consequently, withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, as to amended claims 39 and 40 is respectfully solicited.

IV. Claims 1 and 14 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner contends that these claims are indefinite for reciting intended use.

The rejection is respectfully traversed.

Claims 1 and 14 actually recite “functions” that elements are to carry out. In this regard, attention is directed to MPEP § 2173.01, Claim Terminology:

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as **\*\*>**any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

Further attention is directed to MPEP § 2173.05(g) Functional Limitations:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that

the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated function." "In the absence of modifiers, general descriptive terms are typically construed as having their full meaning." *Id.* at 1118, 72 USPQ2d at 1006. In the patent claim at issue, "subject to any clear and unmistakable disavowal of claim scope, the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." *Id.* at 1120, 72 USPQ2d at 1008

Finally, 35 U.S.C. § 112, sixth paragraph, permits Applicants to recite a "means plus function". Surely there can be no doubt that an "element" plus function can be recited.

In view of the above, withdrawal of the rejection of claims 1 and 14 under 35 U.S.C. § 112, second paragraph, is respectfully solicited.

V. Claim 41 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner inquires as to what is a "function" that is recited in the claim.

By this response, claim 41 has been amended to delineate:

A computer program product comprising a recording medium having encoded thereon a computer readable program executable by an information processing device of an image storing apparatus to carry out the operations of:

receiving the image at a receiving device of the image storing apparatus from a customer-side communication apparatus;

recording the received image at a recording device of the image storing apparatus;

determining, by a determining device of the image storing apparatus, whether or not to move the image recorded on the recording device to a record medium by comparing at least one of capacity, quantity, a recording period and a current date thereof recorded on the recording device to at least one of corresponding predetermined thresholds; and

moving, by a moving device of the image storing apparatus, the image recorded on the recording device to the record medium based on results of the determination.

Thus, amended independent claim 41 is believed to recite the invention with the degree of precision and particularity required by the statute. Therefore, it is respectfully urged that the rejection be withdrawn.

VI. Claim 42 has been rejected under 35 U.S.C. § 112; second paragraph, as being indefinite. The Examiner contends that claim 43 combines two statutory classes of invention and consequently, is not sufficiently precise to provide competitors with an accurate determination of the metes and bounds of protection involved, referring to MPEP § 2173.04(p)(II).

By this response, claim 42 has been amended to recite:

An image storing method comprising:  
receiving an image from a customer-side communication apparatus;  
recording the received image on a recording device;  
determining whether or not to move the image recorded on the recording device to a record medium by comparing at least one of capacity, quantity, recording period and a current date thereof recorded on the recording device to corresponding one of predetermined thresholds; and  
moving the image recorded on the recording device to the record medium based on results of the determination.

Thus, amended claim 42 does not combine two statutory classes of invention. Consequently, withdrawal of the rejection of claim 42 under 35 U.S.C. § 112, second paragraph, is respectfully solicited.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 101**

Claims 41 and 42 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

However, amended claims 41 and 42 are believed to be directed to statutory subject matter. Consequently, withdrawal of the rejection under 35 U.S.C. § 101 as to amended claims 41 and 42 is respectfully solicited.

**REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103**

I. Claims 1-4, 6, 9-16, 18, 21-25, 27-31 and 33-42 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Jackson et al. (USPN 6,760,128).

The rejections are respectfully traversed.

Independent claims 1 and 14 as amended, delineate, *inter alia*:

a receiving device which receives image selection information indicating that the stored image is selected to remain stored and not removed from the image storing device...

Independent claim 12, as amended, delineates, *inter alia*:

a sending device which sends the image selected by the image selecting device and image selection information indicating that the stored image is selected to remain stored and not removed.

Thus, in claim 1, 14 and 27, the selection information (from a customer) indicates that the (particular) stored image is selected to remain stored and not removed. Attention is directed to page 11, lines 5-9 and page 12, lines 5-8 of the present application, which support this subject matter. In the system described in the present application, a customer pays a usage charge based



on a using and storing area and the storing period. Thus, the smaller the using and storing area and/or the storing period, the smaller is the charge. Therefore, there is an incentive for the customer to have images removed from storage that do not need to be stored any longer. Consequently, unless the system receives (from the customer) an indication that an image that is currently stored is selected to remain stored, that image will be removed from storage.

As noted in the previous response, the system of Jackson et al. does not have this feature. Jackson et al. merely discloses that "a user selects images to be uploaded" (see Fig. 2 and column 5, lines 58-64 of Jackson et al.). The incentive disclosed in Jackson et al. is to order photo products as early as possible, as the price of order photo products increases as the time from uploading increases. While Jackson et al. discloses that a user may be given a discount for deleting some number of unwanted images from their account prior to ordering photo products, such indication is an indication to delete an image which is opposite of what is now recited in amended independent claims 1, 14 and 27. That is, in Jackson et al., each image is automatically saved unless the customer selects an image to be deleted. In contrast, in the present invention, an image is automatically deleted unless the system receives an indicating signal (from the customer) that an image that is currently stored is selected to be kept stored (and not removed from the storage device).

Thus, independent claims 1, 14 and 27, as amended, are patentable over Jackson et al., as are dependent claims 2-4, 6, 8-13, 15, 16, 20-25, 28-31.

Claim 2 recites:

wherein:

the receiving device receives image attribute information indicating an attribute of the image as one piece of the image selection information; and

the image management information storing device stores the image stored in the image storing device and indicated by the image attribute information received by the receiving device by associating the image with the image attribute information and the customer information stored in the customer information storing device.

Dependent claim 15 has similar recitations.

The Examiner has again referred to column 6, lines 34-38 of Jackson et al. as disclosing these features. However, as noted in the previous response, the above-noted portion at column 6, lines 34-38 describes adding to “the user’s *service account*” the image identifiers corresponding to the customer’s uploaded images and the designated date. This is different from what is recited in the claims in that the image management information storing device stores the image stored in the image storing device (and indicated by the image attribute information received by the receiving device) by associating the image with the image attribute information and the customer information stored in the customer information storing device. Jackson et al. does not disclose that “the user’s *service account*” stores an image that was uploaded and previously stored.

Claim 3 recites:

wherein the image storing device and the image management information storing device are the same database.

In the Office Action, the Examiner continues to maintain that this feature is disclosed at column 4, lines 21-23 of Jackson et al., which describes:

The electronic database 44 ***provides information describing numerous photo product options, including printing a group of digital images onto album pages.*** The electronic database 44 can be contained on the same computer as the network server 42, or can utilize a separate computer, or can be distributed over several computers at the same physical site, or at different sites. (Emphasis Added)

As noted in the previous response, there is clearly no description in this portion of Jackson et al. that electronic database 44 stores images, as required by claim 3. More specifically, as recited in independent claim 1, from which claim 3 depends, the image storing device stores the image captured by the image capturing device.

Claim 28 recites:

wherein the sending device sends image attribute information indicating an attribute of the image as one piece of the image selection information.

In the Office Action, the Examiner has again maintained that this feature is disclosed at column 5, lines 45-47 of Jackson et al., which describes:

...This service account information will later be augmented by additional information providing an image identifier and designated date for each uploaded image, and the photo product options selected by the customer. FIG. 5 provides an example of the service account information.

As noted in the previous response, there is clearly no description in this portion of Jackson et al. that a sending device ***sends image attribute information indicating an attribute of the image as one piece of the image selection information.***

Dependent claim 9 recites, *inter alia*:

a receiving device which receives customer reading authorization information indicating that the customer has authorized the customer information to be read; and ...

***sends the read customer information to another customer.*** (Emphasis Added)

Dependent claim 21 has recitations that are similar.

Dependent claim 29 recites, *inter alia*:

a sending device which sends the customer reading authorization information inputted by the input device.

In the Office Action, the Examiner has continued to maintain that this feature is disclosed at column 5, lines 26-40 of Jackson et al., which describes:

In block 102, the ***user enters their name, selects a password, and provides delivery and billing information. This information identifies the user and one or more designees (e.g. a person to whom the photo product 66 should be shipped, which can of course be the user).*** It includes addresses of both the user and the user's designees. The user also identifies an account to be debited to pay for the photo product(s) to be purchased. Often this will be a credit card having a payment identifier that specifies the account of the customer to be charged or debited. Frequently, this will be in a financial institution. The payment identifier can be a credit card number that specifies a particular credit card account. As used in this specification, a credit card will also include a debit card. (Emphasis Added)

As noted in the previous response, this portion of Jackson et al. clearly delineates that the designee is someone to whom a purchased photo product is to be shipped. There is no description regarding inputting and/or sending a ***customer reading authorization*** information, or that a designee is sent ***read customer information***.

Independent claim 33 recites, *inter alia*:

a determining device which determines whether or not to move the image recorded on the recording device to a record medium by comparing at least one of the capacity, quantity, recording period and a current date thereof recorded on the recording device to corresponding at least one of predetermined thresholds...

In the Office Action, the Examiner has continued to maintain this feature is disclosed at column 3, lines 45-67 ("CPU") of Jackson et al., which describes:

The home computer system 10, which can be, for example, a Dell Dimension XPS M200, includes a CPU motherboard 12, using, for example, a Pentium 200 MHz MMX processor as well as RAM memory. The CPU motherboard 12 executes software stored on a hard drive 20, for example, the well known Windows 98 operating system software and the Internet Explorer web browser software, both provided by Microsoft Corp. of Redmond, Wash. The CPU motherboard 12 is coupled to a display monitor 14 and a keyboard 16. A mouse 18 permits the customer to readily communicate with the CPU motherboard 12. The customer's computer 10 also includes a dial-in modem 22 for communicating with the ISP 30 in order to connect to a channel 36, such as the Internet.

The CPU motherboard 12 communicates with a color scanner 4, such as a Microtek ScanMaker E6, which can scan color photographs (not shown) and store digital images of the photographs on the hard drive 20. The CPU motherboard 12 also communicates with a CD reader 2. The CD reader 2 can be used to input digital images from a CD-R disc, such as a Kodak PictureCD (not shown). The CPU motherboard 12 also communicates with a digital camera 6 via a suitable interface, such as the well known USB or RS-232 serial interfaces.

Amended independent claim 41 recites, *inter alia*:

determining, by a determining device of the image storing apparatus, whether or not to move the image recorded on the recording device to a record medium by comparing at least one of capacity, quantity, a recording period and a current date thereof recorded on the recording device to at least one of corresponding predetermined thresholds...

Amended independent claim 42 recites, *inter alia*:

determining whether or not to move the image recorded on the recording device to a record medium by comparing at least one of capacity, quantity, recording period and a current date thereof recorded on the recording device to corresponding one of predetermined thresholds..

In the Office Action, the Examiner maintains these features, which correspond to the features recited in claims 41 and 42 in the previous response, are disclosed at column 6, lines 34-38 (“the image identifiers”) of Jackson et al., which describes:

In block 109, the image identifiers corresponding to each of the customer's uploaded images, and the designated date indicating the date the image was uploaded, are added to the user's service account information. The image identifier can be the file name of the uploaded image.

As noted in the previous response, there is no disclosure of “comparing at least one of the capacity, quantity, recording period and a current date thereof recorded on the recording device to corresponding at least one of predetermined thresholds” in order to determine whether or not to move the image recorded on the recording device to a record medium (last portion of each of independent claims 33, 41 and 42) at column 3, lines 45-67 or column 6, lines 34-38.

Amended claim 39 recites:

wherein the recording device does not record an image that is a duplicate of an image that is already recorded on the recording device.

In the Office Action, the Examiner contends that this feature, which corresponds to the feature recited in claim 39 in the previous response, is disclosed at column 11, lines 12-14 of Jackson et al., which describes:

In block 124, the production controller 52 produces the customized photo products using the uploaded images and the service account information (see FIG. 5) stored in electronic database 44.

As noted in the previous response, there is no disclosure regarding the recording device not record a duplicate of an image that has already been recorded on the recording device.

Amended claim 40 recites:

wherein the moving device does not move an image that is a duplicate of an image that has already been moved to the record medium.

In the Office Action, the Examiner contends that this feature, which corresponds to the feature recited in claim 40 in the previous response, is disclosed also at column 11, lines 12-14 of Jackson et al. However, as noted in the previous response, referring to the above-noted description at column 11, lines 12-14 of Jackson et al., it is clear that there is no disclosure regarding the moving device does not move an image that is a duplicate of an image that has already been moved to the record medium.

Applicants note that in the present Office Action, it does not appear that the Examiner has addressed Applicants' arguments in the previous response as to what is not disclosed in Jackson et al. with regard to claims 2, 3, 9, 21, 29, 28 and 33. Consequently, the present Office action is not complete (see MPEP § 707.07 Completeness and Clarity of Examiner's Action).

In view of the above, claims 1-4, 6, 9-16, 18, 21-25, 27-31 and 33-42, as amended, are patentable over Jackson et al. and their allowance is respectfully solicited.

**II.** Claims 7, 8, 19 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jackson et al., as applied to claims 1-4, 6, 9-16, 18, 21-25, 27-31 and 33-42.

However, claims 7 and 8 depend indirectly from independent claim 1 and claims 19 and 20 depend indirectly from independent claim 14. Consequently, they are patentable over Jackson et al. also.

**III.** Claims 5 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jackson et al., as applied to claims 1-4, 6, 9-16, 18, 21-25, 27-31 and 33-42, in view of Manolis et al. (USPN 6,583,799).

Manolis et al. does not disclose “a receiving device which receives image selection information indicating that the stored image is selected to remain stored and not removed from the storage device”, as now recited in amended independent claims 1 and 14. As claim 5 depends indirectly from amended independent claim 1 and claim 17 depends indirectly from amended independent claim 14, they are patentable over Jackson et al. also, even when considered in view of Manolis et al. Consequently, the allowance of claims 5 and 17 is respectfully solicited.

**IV.** Claims 26 and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jackson et al. as applied to claims 1-4, 6, 9-16, 18, 21-25, 27-31 and 33-42, in view of Cook et al. (USPN 6,786,655).

Cook et al. also does not disclose “a receiving device which receives image selection information indicating that the stored image is selected to remain stored and not removed from



the storage device”, as now recited in amended independent claim 14 and “a sending device which sends the image selected by the image selecting device and image selection information indicating that the stored image is selected to remain stored and not removed”, as now recited in amended independent claim 27. As claim 26 depends directly from amended independent claim 26 and claim 32 depends directly from amended independent claim 27, they are patentable over Jackson et al. also, even when considered in view of Cook et al. Consequently, the allowance of claims 26 and 32 is respectfully solicited.

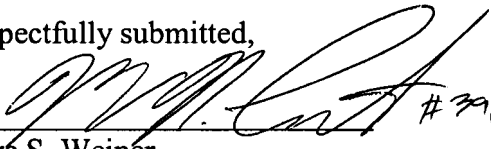
#### **CONCLUSION**

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to contact Edward. J. Wise Reg. No. 34,523 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: July 11, 2007

Respectfully submitted,

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